REMARKS

Claims 4 and 5 remain in the case.

The Applicant cancels claims 1 and 2, and amends claims 4 and 5 to better describe the invention. All amendments are fully supported by the application as filed. More specifically, the feature of a hydraulic bore seal telescopic hoist formed of a series of telescopically arranged tubular sections in a semi-lubricated contact between each other can be found at paragraphs [0001], [0006], [0012], [0018]; the feature of a hoist that allows ambient air to freely enter in the hoist between a piston head and tubular section thereof is found at paragraph [0012]. No new matter has been entered.

Reconsideration of this Application is requested.

INTERVIEW SUMMARY

Applicant expresses his appreciation of the Examiner's courtesy and cooperation in the interviews which were conducted with the undersigned counsel for the Applicant on September 4 and September 10, 2009.

In the September 4 interview, the procedural history of the application was discussed, including whether the Office Action issued on June 10, 2009, was properly a final rejection, in view of the fact that the rejection was based upon newly cited references after the Office properly withdrew references cited in the Office Action previously issued on March 3, 2009. The prior art cited by the Office in the June 10, 2009, Office Action, and certain amendments to the claims, were also discussed. No agreement was reached on these issues during this interview. In connection with certain possible changes to the claims, as discussed between the Examiner and counsel, the Examiner indicated that she would speak further to counsel for the Applicant at the time the amendment was ready to file.

In the September 10 interview, the propriety of the final rejection and additional amendments to the claims were discussed. Again no agreement was reached.

THE REJECTION ON JUNE 10, 2009 WAS NOT PROPERLY MADE FINAL

Applicant asserts that the June 10, 2009 Office Action should not have been a Final Action, because the rejection was based upon new art, without any amendment of the claims by the Applicant. In the March 3 Office Action, the main reference was Mainville, U.S. Patent No. 6,938,538. In response, on March 19, 2009, Applicant submitted a declaration under 35 U.S.C. § 102(e)/103, that is, a statement indicating that the inventor of the '538 reference was the same person as the present inventor, and that therefore the '538 reference not properly prior art and should be withdrawn. No amendments were made to any of the claims, and no new information disclosure statement was filed.

Under MPEP § 706.07(a), "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement." That same section goes on to say "If such a statement [averring common ownership at the time the invention was made] is filed in reply to the 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made."

In the September 10 interview, the Examiner indicated that if the new ground of rejection was in response to a declaration, then it could be made final. That only applies if a reference is disqualified under the joint research agreement provision of 35 U.S.C. 103(c), not to a statement averring common ownership at the time the invention was made under 35 U.S.C. 102(e)/103, as was the case here.

Therefore, Applicant respectfully requests that the Office withdraw the finality of the June 10 rejection as premature, under MPEP § 706.07(d).

REJECTIONS UNDER 35 U.S.C. § 103, FIRST PARAGRAPH

The Office has rejected claims 1, 2, 4 and 5 as being unpatentable over **Neubauer** (5099748) in view of **Nottenboom** (3653302) and **Terjwin** (6337459), under

35 U.S.C. § 103, first paragraph. Claims 1 and 2 are cancelled herewith, and claim 3 had previously been cancelled. Insofar as the rejection may continue to apply to amended claims 4 and 5, Applicant respectfully disagrees. Amended claims 4 and 5 are not obvious over the cited references.

The cited references considered alone or in combination do not provide a hydraulic bore seal telescopic hoist formed of a series of telescopically arranged tubular sections, in a semi lubricated contact with each other because of the film formed by the fluid interacting with the surface asperities, that allows ambient air to freely enter in the hoist between a piston head and a tubular section of the hoist.

Neubauer describes a pneumatic telescopic mast comprising tubular sections 12a-12d, each having a bottom piston unit 16 (see Figure 2a), with a central air passage 39 controlled by a ball 40 under action of a probe 44, so as to move up or down successively the tubular sections under action of compressed air (passage 47). **Neubauer** does not use fluid. While **Neubauer** does include some seals, as pointed out by the Office, **Neubauer** does not disclose a shaft formed of a series of telescopically arranged tubular sections, with semi lubricated contact between each other, or any seals that separate fluid from one end of the tubular sections from ambient air on a second, opposite end of the tubular sections, as recited in Applicant's claims.

Notenboom relates to a double acting telescoping hoist that is closed at one end by the outer piston 12 and at the opposite end by a plug 31. **Notenboom**'s is a closed system, like that described as part of the Background of the Invention section in Applicant's specification at paragraph [0003]. It is not open to ambient air or the atmosphere as required by Applicant's pending claims. **Notenboom** does not disclose a telescopic hoist having tubular sections, in a semi lubricated contact between each other, as also required by Applicant's pending claims.

Terjwin et al. relates to multi-layered anti-coking heat resisting metal tubes required in carburization-hardening furnaces, cracking tubes of thermal decomposition furnaces, or other petrochemical thermal cracking furnace tube applications. There is no mention or hint in **Terjwin et al**. that there may be an advantageous use of surface asperities, and no indication that a lubricating film would form on the surface of the tubes disclosed in **Terjwin et al**.

Therefore, the Office has not provided a reasonable articulated line of reasoning as to why a person of skill in the art would, at the filing date of the present application, have 1) considered **Neubauer** since it addressed a problem completely unrelated to that of the present invention, and 2) considered it in combination with **Notenboom** and **Terjwin et al.**, which also fail to address any problem related to that of the present invention.

The combination of the present invention allows taking advantage of the porosity of nitrided steel, which is higher than that of untreated steel, to create a semi-lubricated contact, while nitridation yields much higher hardness, preserves high dimensional stability, and achieves mechanical resistance of the tubes and protection from debris (see paragraphs [0003] and [0004] of the application). Prior to the present invention, using steel was problematic because of the steel to steel contact between the tubular sections, and no one had thought of such combination. This valuable invention is simply nowhere to be found in the cited references.

The Supreme Court in the recent KSR case stated that "[...] there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" [...] *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

By contrast, in the Office Action, it is stated that [...] "it would have been obvious to one of ordinary skill in the art to modify Neubauer to include steel roughened

or asperities surface to protect the steel while enabling the fluid to move over the surfaces." Action page 3.

In this statement, the Office may be using hindsight. The problem of accumulation of debris and wear in rod seal type cylinders has traditionally been addressed by using dynamic and static seal means for sealing and wiper means for removing debris from a surface along which the dynamic seal means slidably contacts. Problems kept recurring, including contamination of the wipers, wear of the wear rings. In bore seal type cylinders, breathers are very quickly filled which results in air being pushed and aspired through the wipers installed on the piston heads, and these wipers very rapidly become damaged, thereby leaving debris to contaminate the hoist. The industry knew about accumulation of debris and wear being associated with these types of wipers or breathers, together with the material of the wear rings. However, any form of association between improved hoist performance and wear resistance with the surface conditions of the tubular surfaces was heretofore unknown. There was no reasonable expectation of success. Other strategies for improving hoist performance and wear resistance were at play. It was surprising and completely against expectation that particular conditions of the tubular surface itself could lead to a marked advance in hoist performance and wear resistance.

In view of the above and foregoing, it is respectfully requested that the Office withdraw its rejection of claims 4 and 5 under 35 U.S.C. § 103, first paragraph.

The rejections of the claims are believed to have been overcome by the present amendments and remarks. From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such an action is earnestly solicited. Upon receipt of this response, the Examiner is invited to telephone the undersigned to further discuss the prosecution of this application.

Respectfully submitted,

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